

REMARKS

Claims 21, 26, 27, 34, 37-39 and 50 are amended. The attachment to this Amendment entitled "Versions With Markings To Show Changes Made" is a marked-up version of the changes made to the claims. The Applicant has carefully and thoughtfully considered the Office Action and the comments therein. For the reasons given below, it is submitted that this application is in condition for allowance.

1. The Applicant thanks Supervisory Primary Examiner (SPE) Tariq R. Hafiz and Examiner M. Irshadullah for the telephone interviews on December 16, 19, and 20, 2002. The substance of the interviews are now made of record per 37 C.F.R. §1.133(b).

During the interviews, SPE Hafiz agreed to allow claims for this application that were similar in scope to those allowed in the parent application, namely U.S. Patent No. 6,202,052. At the direction of SPE Hafiz, Examiner Irshadullah stated that independent claims 21, 26, and 50 would be allowable as having scopes similar to those of claim 20 of the '052 patent. However, the preambles of independent claims 21, 26, and 50 would need to be amended to recite tax data collecting.

2. According to the request by SPE Hafiz and Examiner Irshadullah, independent claims 21, 26, and 50 are amended. Namely, the preambles of independent claims 21, 26, and 50 are amended to recite tax data collecting. Hence, amended claims 21, 26, and 50 are allowable, and such allowance is respectfully requested.

Further, the claims depending from amended claims 21, 26, and 50 are allowable as being dependent from an allowable claim. Specifically, claims 22-25 and 42-45 are dependent from

amended claim 21 and are allowable as being dependent from an allowable claim. Claims 46-49 are dependent from amended claim 26 and are allowable as being dependent from an allowable claim. Claims 51-53 are dependent from amended claim 50 and are allowable as being dependent from an allowable claim.

In summary, claims 21-26 and 42-53, as amended, are in condition for allowance, and such allowance is respectfully requested.

3. In the Office Action on pages 3-5 in section 9, claims 26, 34-36, and 37-39 are rejected under 35 U.S.C. § 101. On page 5 in section 11, claims 21-25, 27-33, 37, 42-45, and 39 are rejected under 35 U.S.C. § 112, second paragraph. On pages 5-6 in section 12, claims 21-39 and 41-53 are rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully traverses these rejections.

As discussed above, independent claims 21, 26, and 50 are amended at the direction of SPE Hafiz and Examiner Irshadullah to place these claims and their dependent claims in condition for allowance, which thereby renders these rejections moot.

Further, the preambles of independent claims 27, 34, and 37-39 are amended in a similar fashion as those of allowable claims 21, 26, and 50, and the preamble of independent claim 40 is currently pending in a similar fashion as those of allowable claims 21, 26, and 50. As the amended preambles of claims 21, 26, and 50 overcome these rejections, the amended preambles of claims 27, 34, 37, 38, and 39 and the preamble of claim 40 similarly overcome these rejections. Hence, these rejections are likewise rendered moot for claims 27, 34, and 37-40 and their dependent claims

4. In the Office Action on page 6 in section 13, claims 40 and 41 are rejected under 35 U.S.C. § 112, second paragraph. The Office Action asserts that the recited “information” and “information provider” are unclear/vague/indefinite and that the claims fail to recite the nature/type/constituent elements. Applicant respectfully traverses this rejection.

The recitation of “information” and “information provider” **must** be given their **plain meaning**. “During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their **plain meaning** unless applicant has provided a clear definition in the specification.” M.P.E.P. § 2111.01. A clear definition for “information” and “information provider” is not provided in the specification, and, thus, these phrases must be given their **plain meaning**. As one option as to their plain meaning, according to the Webster’s New World Dictionary, Second College Edition (1982), “information” is defined in the third instance as “knowledge acquired in any manner; facts; data; learning; lore,” and “provider” is defined as the noun for “provide,” which is defined in the second instance as “to make available; supply; afford.” Hence, according to the plain meaning of these phrases, claims 40 and 41 comply with the requirements of section 112.

Further, “information” and “information provider” should not be limited to tax data and tax data provider, respectively, as noted in the Office Action on pages 18-19 in section 16(b). Under the doctrine of claim differentiation, these phrases are broader. Specifically, in claim 41, which depends from claim 14, “information” is recited as comprising tax data, and “information provider” is recited as comprising a tax data provider. According to the application, non-limiting examples of tax data include the following: a payroll statement, a bank statement, a savings and loan statement, a mortgage statement, a credit card bureau statement, a thrift institution statement, a brokerage account statement, a mutual fund statement, or a charity

statement. Specification, page 13, lines 2-5. A tax data provider is discussed in the specification, for example, on page 9 at line 18 to page 10 at line 2, and refers to a party that has tax information relevant to the taxpayer's tax liability or tax reporting obligations. As illustrated in Figure 2 of the application, non-limiting examples of a tax data provider include the following: the taxpayer's employers 22, the taxpayer's banks 23, the taxpayer's brokerage firms 24, the taxpayer's charities 25, the taxpayer's other tax data providers 26, and taxing authorities 27. Hence, according to the doctrine of claim differentiation, "information" and "information provider" should not be limited to tax data and tax data provider, respectively.

5. In the Office Action on pages 6-17 in section 15, claims 21-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,193,057 to Longfield (hereinafter Longfield) in view of U.S. Patent No. 5,138,549 to Bern (hereinafter Bern). Applicant respectfully traverses this rejection.

As discussed above, independent claims 21, 26, and 50 are amended at the direction of SPE Hafiz and Examiner Irshadullah to place these claims and their dependent claims in condition for allowance, which thereby renders these rejections moot. Hence, claims 21-26 and 42-53, as amended, are allowable.

Claim 27 recites an apparatus for receiving information on a tax data provider comprising means for connecting electronically an electronic intermediary to a taxpayer and means for receiving electronically information on at least one tax data provider from the taxpayer. Referring to Figure 2 of the specification, the electronic intermediary 21 is separate from the taxpayer 20. As discussed in the specification, for example, on page 9 at lines 14-18, the term "taxpayer" refers to an individual or other entity, such as a trust, estate, corporation, or

partnership, who has tax liability or must file a tax return, and the term “electronic intermediary” refers to a data processing system comprising a general purpose computer and a computer program for performing the invention.

The electronic intermediary is connected electronically to the taxpayer. Electronically connecting the electronic intermediary and the taxpayer is discussed in the specification, for example, on page 10, line 16, to page 11, line 3. The electronic intermediary electronically receives information on at least one tax data provider from the taxpayer. The information electronically received on at least one tax data provider from the taxpayer is discussed in the specification, for example, on page 10 at lines 3-15. As discussed in the specification, for example, on page 9 at line 18 to page 10 at line 2, the term “tax data provider” refers to a party that has tax information relevant to the taxpayer’s tax liability or tax reporting obligations. As illustrated in Figure 2, non-limiting examples of a tax data provider include the taxpayer’s employers 22, the taxpayer’s bank 23, the taxpayer’s brokerage firms 24, the taxpayer’s charities 25, the taxpayer’s other tax data providers 26, and taxing authorities 27. A tax data provider is not the same as the taxpayer 20.

In rejecting claim 27, the Office Action incorrectly aligns the limitations of claim 27 with those of claim 21. The first and second limitations of claim 27 are not the same as the first and second limitations of claim 21. Specifically, as noted above, a taxpayer is not the same as a tax data provider. Hence, the Office Action has failed to address the limitations of claim 27.

Further, Longfield in view of Bern fails to teach the limitations of claim 27. Specifically, Longfield teaches manually collecting tax data and manually entering the collected tax data into a personal computer by using a keyboard. Longfield, column 2, lines 14-23; column 3, lines 40-41, 46-47, and 56-58. Longfield fails to teach collecting information on at least one tax data

provider from the taxpayer. In addition, Bern fails to overcome the failings of Longfield.

Specifically, Bern teaches manually entering data into a computer using a touch tone telephone, a keyboard, or speech recognition. Bern, column 7, lines 33-38; column 2, lines 62-64. Bern fails to teach entering information on at least one tax data provider from a taxpayer. Hence, the combination of Longfield and Bern fails to teach the claimed invention. Consequently, the Office Action has failed to establish a prima facie case of obviousness for claim 27, and it is respectfully submitted that claim 27 is allowable.

Claims 28-33 variously depend from claim 27 and are allowable as being dependent from an allowable claim.

Further, claim 32 recites limitations similar to two of the four limitations recited in claim 20 of the '052 patent, and claim 33 depends from claim 32 and recites limitations similar to the remaining two of the four limitations recited in claim 20 of the '052 patent. Hence, according to the indication by SPE Hafiz and Examiner Irshadullah, claim 33 should be allowable as reciting limitations similar in scope to those allowed in the '052 patent.

Moreover, the Applicant respectfully asserts that the combination of Longfield and Bern fails to teach the invention of claim 32. Claim 32 depends from claim 27 and further recites means for connecting electronically an electronic intermediary to one of the at least one tax data provider and means for collecting electronically tax data from the at least one tax data provider. In contrast to the claimed invention and as recognized by the Office Action on page 7, Longfield does not teach connecting electronically an electronic intermediary to a tax data provider and collecting electronically tax data from the tax data provider. Instead, Longfield teaches manually collecting tax data and manually entering the collected tax data into a personal

computer by using a keyboard. Longfield, column 2, lines 14-23; column 3, lines 40-41, 46-47, and 56-58. Hence, Longfield fails to teach the claimed invention.

Just like Longfield, Bern fails to teach the claimed invention and fails to overcome the deficiencies of Longfield. Bern does not teach connecting electronically an electronic intermediary to a tax data provider and collecting electronically tax data from the tax data provider. In fact, Bern does not teach any steps related to determining tax liability. Instead, Bern teaches a method for a depositor to deposit funds electronically to pay a tax liability. Bern, column 1, line 16, to column 2, line 15; especially, column 1, line 16-21 and 32-42; column 2, lines 19-34. In addition to failing to teach anything related to determining tax liability, Bern only teaches manually entering data into a computer using a touch tone telephone, a keyboard, or speech recognition. Bern, column 7, lines 33-38; column 2, lines 62-64. Hence, Bern, does not teach the claimed invention and does not overcome the deficiencies of Longfield. In addition, the combination of Longfield and Bern fails to teach the claimed invention. Consequently, the Office Action has failed to established a prima facie case of obviousness for claim 32, and it is respectfully submitted that claim 32 is allowable.

Claim 34 recites limitations similar to those recited for claim 27, except in the format of a computer-readable medium embodying a computer program. For the same reasons discussed above for claim 27, claim 34 is likewise allowable.

Claims 35 and 36 depend from claim 34 and are allowable as being dependent from an allowable claim.

Further, claims 35 and 36 recite limitations similar to those recited for claims 32 and 33, respectively, except in the format of a computer-readable medium embodying a computer

program. For the same reasons discussed above for claims 32 and 33, claims 35 and 36, respectively, are likewise allowable.

Claims 37 and 38 recite limitations similar to two of the four limitations recited in claim 20 of the '052 patent. Specifically, claims 37 and 38 recite limitations similar to those recited in claim 32. For the same reasons discussed above for claim 32, claims 37 and 38 are likewise allowable.

Claim 39 recites limitations similar to those recited in claim 27. For the same reasons discussed above for claim 27, claim 39 is likewise allowable.

Claim 40 recites limitations similar those recited in claim 20 of the '052 patent, except for the broader recitations based on information, instead of specifically on tax. In particular, claim 40 recites connecting electronically an electronic intermediary to an information provider, collecting electronically information from the information provider, processing electronically the information collected electronically from the information provider to obtain processed information, and preparing electronically an electronic information report using the processed information.

In contrast to the claimed invention and as recognized by the Office Action on pages 14 and 7, Longfield does not teach connecting electronically an electronic intermediary to an information provider and collecting electronically information from the information provider. Instead, Longfield teaches **manually** collecting tax data and **manually** entering the collected tax data into a personal computer by using a keyboard. Longfield, column 2, lines 14-23; column 3, lines 40-41, 46-47, and 56-58. Hence, Longfield fails to teach the claimed invention.

Just like Longfield, Bern fails to teach the claimed invention and fails to overcome the deficiencies of Longfield. Bern does not teach connecting electronically an electronic

intermediary to an information provider and collecting electronically information from the information provider. In fact, Bern does not teach any steps related to collecting information electronically. Instead, Bern teaches a method for a depositor to deposit funds electronically to pay a tax liability. Bern, column 1, line 16, to column 2, line 15; especially, column 1, line 16-21 and 32-42; column 2, lines 19-34. In addition to failing to teach anything related to collecting information electronically, Bern only teaches manually entering data into a computer using a touch tone telephone, a keyboard, or speech recognition. Bern, column 7, lines 33-38; column 2, lines 62-64. Hence, Bern, does not teach the claimed invention and does not overcome the deficiencies of Longfield. In addition, the combination of Longfield and Bern fails to teach the claimed invention. Consequently, the Office Action has failed to established a prima facie case of obviousness for claim 40, and it is respectfully submitted that claim 40 is allowable.

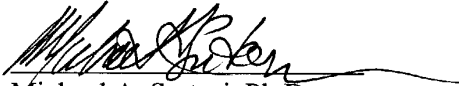
Claim 41 depends from claim 40 and is allowable as being dependent from an allowable claim.

Further, claim 41 recites limitations similar to claim 20 of the '052 patent. Hence, according to the indication by SPE Hafiz and Examiner Irshadullah, claim 41 should be allowable as reciting limitations similar in scope to those allowed in the '052 patent.

THEREFORE, because all rejections have been overcome, it is submitted that claims 21-53 are allowable, and such allowance is requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 21, 26, 27, 34, 37, 38, 39, and 50 are amended as follows:

21. (Amended) An apparatus for collecting tax data comprising:

means for connecting electronically an electronic intermediary to a tax data provider;

means for collecting electronically tax data from said tax data provider;

means for processing electronically said tax data collected from said tax data provider to obtain processed tax data; and

means for preparing electronically an electronic tax return using said processed tax data.

26. (Amended) A computer-readable medium embodying a computer program for collecting tax data, said computer program comprising code segments for:

connecting electronically an electronic intermediary to a tax data provider;

collecting electronically tax data from said tax data provider;

processing electronically said tax data collected from said tax data provider to obtain processed tax data; and

preparing electronically an electronic tax return using said processed tax data.

27. (Amended) An apparatus for receiving information on a tax data provider comprising:

means for connecting electronically an electronic intermediary to a taxpayer; and

means for receiving electronically information on at least one tax data provider from said taxpayer.

34. (Amended) A computer-readable medium embodying a computer program for receiving information on a tax data provider, said computer program comprising code segments for:

connecting electronically an electronic intermediary to a taxpayer; and
receiving electronically information on at least one tax data provider from said taxpayer.

37. (Amended) An apparatus for providing tax data comprising:
means for connecting electronically a tax data provider to an electronic intermediary; and
means for providing electronically tax data from said tax data provider to said electronic intermediary.

38. (Amended) A computer-readable medium embodying a computer program for providing tax data, said computer program comprising code segments for:
connecting electronically a tax data provider to an electronic intermediary; and
providing electronically tax data from said tax data provider to said electronic intermediary.

39. (Amended) An apparatus for proving information on a tax data provider comprising:
means for connecting electronically a taxpayer to an electronic intermediary; and

means for providing electronically information on at least one tax data provider from said taxpayer to said electronic intermediary.

50. (Twice Amended) A method for automatic tax data collecting by an electronic intermediary comprising:

connecting electronically said electronic intermediary to a tax data provider;
collecting electronically tax data from said tax data provider, wherein said tax data is reported on an Internal Revenue Service ("IRS"), state, local, or foreign tax form;
processing electronically said tax data collected electronically from said tax data provider to obtain processed tax data; and
preparing electronically an electronic tax return using said processed tax data.

